

REMARKS/ARGUMENTS

AMENDMENTS TO THE FIGURES

The following changes are requested to address inadvertent errors in the Figures of the specification as originally filed. Four corrected Figure sheets are attached at the end of this Amendment. A description of the requested Amendments to the Figures follows:

1. Fig. 4. Error: Item number 57 appears twice in the Figure. Number 57 at the center of the page designating air gap 57 is correct; the number 57 that appears between numbers 59 and 50 at the upper left portion of Fig. 4 is in error and should be deleted. Support for this correction may be found in the specification as filed at p.10, lines 5-6 and line 17.
2. Fig. 5. Error: Item number 57 is in error and should be deleted. Fig. 5 shows the latchable reed switch of the present invention in the "closed" position (p.8, lines 2-3). In the closed position, the reeds of the reed switch come together, eliminating the presence of any air gap. Thus, there is no air gap between reeds 52 and 53 in Fig. 5, and number 57 should be deleted. Support in the specification may be found at p.10, lines 5-6 and line 17.
3. Fig. 6. Error: Item number 57 is shown incorrectly. Item 57, the air gap between the reeds of the reed switch, should correctly point to the space between reed 52 and reed 53. For support, see the specification as filed at p.10, lines 5-6 and line 17.
4. Fig. 8. Error: Item number 57 is shown incorrectly. Item 57, the air gap between the reeds of the reed switch, should correctly point to the space between reed 53 and reed connected to lead 54, which is unnumbered in Fig. 8. For support, see the specification as filed at p.10, lines 5-6 and line 17.

THE STATUS OF THE CLAIMS ARE AS FOLLOWS:

Claims 1-32 are pending in the current application. Claims 1-25 are rejected. Claims 26-32 were withdrawn from consideration, having been drawn to a non-elected invention in the prior Official Action, and have now been canceled.

Independent Claims 1, 15 and 21 and dependent Claim 17 are amended herein, as are Figures 4-6 and 8. None of the foregoing amendments expand the scope of the invention or add new matter to the specification.

Claims 1, 7, 8, 10, 15, 21 and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 4,756,312 (Epley).

Claims 2-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Epley as applied to Claim 1 above, and further in view of U.S. Pat. No. 5,293,523 (Posey '523).

Claims 6 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Epley as applied to Claim 1 above, and further in view of U.S. Pat. No. 5,811,896 (Grad).

Claims 11-13, 16, 20, 24 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Epley.

Claim 14 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Epley as applied to Claim 1 above and further in view of U.S. Pat. No. 5,233,322 (Posey '322).

Claims 17-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Epley as applied to Claim 15 and further in view of U.S. Pat. No. 5,293,523 (Posey '523).

Claim 23 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Epley as applied to Claim 21 and further in view of U.S. Pat. No. 5,811,896 (Grad).

Entry of the requested amendments and favorable consideration of the comments contained herein are requested.

Applicant now addresses each of the Examiner's rejections in turn.

REJECTION UNDER 37 C.F.R. §102(b)

In paragraph 3 on page 2 of the Office Action dated 9 October 2003, the Examiner rejected Claims 1, 7, 8, 10, 15, 21 and 22 under 35 U.S.C. §102(b) as being anticipated by Epley '312. For the following reasons, Applicant believes that the rejection is unwarranted and requests that the rejections based on Epley '312 be withdrawn.

First, the Examiner stated, "Epley discloses a miniature hearing aid device...comprising: electrical circuit means...for exciting the tympanic membrane of the wearer...[and] a reed switch including...a latching magnet directly affixed to one of said first reed or to the lead wire associated with said first reed..." (emphasis added).

Epley describes and claims a magnetic attachment device for the insertion and removal of hearing aids, where the hearing aid is adapted for *mounting* within the ear canal to provide *excitation* of the tympanic membrane through *direct electromechanical coupling* to the ossicles of the ear via a contact element (38) and mounting legs (50) which are bent around the malleus bone (52) after passing *through* the tympanic membrane" (col. 7, lines 45-49) or, alternately, *surgically mounted* on each side of the malleus (col. 8, lines 1-18). Applicant's device requires neither passage through the tympanic membrane, nor mounting on the malleus.

Second, as is well known to the Examiner, in order to sustain a claim of anticipation, a single source must contain all the elements of the claim. Moreover, the single source must disclose all of the claimed elements "arranged as in the claim."

Applicant is unable to find any teaching or suggestion in Epley '312 concerning the direct attachment or direct affixing of a latching magnet directly to a wire lead, one of the actuator reeds of a reed switch or between two reeds of a reed switch. Indeed, in paragraph 5 on p.5 of the same Office Action, the Examiner acknowledges: "Epley *does not expressly disclose* the latching magnet is directly affixed to said first reed or wedged between ferromagnetic lead wires..." (emphasis added). The only mention of a switch would appear to be that of a

“magnetic microswitch” at col. 10, lines 30-31. Thus, Epley is an insufficient reference upon which to base a §102(a) rejection.

Thirdly, as indicated above, the teachings or suggestions, as well as the expectation of success, must come from the prior art, *not* Applicant’s disclosure (see *In re Vaeck*). In a portion of the text quoted from the Examiner above, the underlined text is that of Applicant, and is not found in Epley ‘312. The Examiner may not use Applicant’s own teaching in order to maintain a proper rejection. The Examiner’s rejections to independent Claims 15 and 21 and dependent Claim 22 also contain language taken from Applicant’s specification and not found in Epley ‘312.

For the foregoing reasons, the rejections of independent Claims 1, 15 and 21 and dependent Claims 7, 8, 10 and 22 based on Epley ‘312 are in error and must be withdrawn.

FIRST REJECTION UNDER 35 U.S.C. §103(a)

On page 5, in paragraph 5 of the Office Action dated 9 October 2003, the Examiner rejected Claims 2-5 under 35 U.S.C. §103(a) under Epley ‘312 in view of U.S. Posey ‘523, stating that: “it would have been obvious to one of ordinary skill in the art at the time of the invention to place the *latching magnet of the combination* on the reed...” (emphasis added). With all due respect to the office, Applicant believes that this rejection is in error for the following reasons, and the rejection of Claims 2-5, which are dependent on independent Claim 1, must be withdrawn.

For an obviousness rejection under §103(a) to be maintained, the prior art is compared to the invention as claimed. In order to make out a *prima facie* case of obviousness, one of the required elements is that the prior art reference or combination of references must teach or suggest *all* the limitations of the claims. Furthermore, the teachings or suggestions, as well as the expectation of success, must come from the prior art, *not* Applicant’s disclosure. For the following reasons, the Examiner has not made out a *prima facie* case of obviousness, and the rejection of Claims 9, 10 and 12 must therefore be withdrawn.

The instant invention, as defined by the claims contained herein, concerns a hearing device comprising a *miniature* latching reed switch assembly, not just *any* magnet or reed switch in combination. By contrast, Posey '523 neither discloses nor claims a hearing device, nor a *miniature* latching reed switch assembly remotely similar to that of Applicant. Posey '523 is directed towards a unidirectional magnetic proximity detector that includes a permeable plate (14) for the absorption of magnetic flux, not a miniature latching reed switch as requested by the claims herein.

When Posey's magnetic proximity detector is located sufficiently proximate to a permeable object of relatively high permeability, the reed switch is closed. However, *removal* of the permeable object from the proximate position allows the reed contacts to *open*. See column 4, lines 24-35 (emphasis added). This is in direct contrast to the present invention where, as Applicant discusses in the specification and indicates in Claim 1, the latching magnet of the present invention causes the reeds to be *maintained* together in electrical contact after application of an external control magnet, even after removal of the control magnet from proximity to the reed switch. (See p.6, lines 10-12); p.9, line 19 to p. 10, line 6; p.10, lines 18-21; and p.11, lines 10-15). Posey '523 does not *maintain* the reed switch in open configuration once the permeable object is removed.

For the foregoing reasons, neither Epley '312 nor Posey '523, either alone or taken in combination render instant Claims 2-5 obvious, and are thus inappropriate references upon which to sustain a rejection under 35 U.S.C. §103(a). Withdrawal of the 35 U.S.C. §103(a) rejections and further consideration of the specification and claims are therefore urged at this time.

SECOND REJECTION UNDER 35 U.S.C. §103(a)

In the Office Action dated 9 October 2003 on page 5, paragraph 6, the Examiner rejected dependent Claims 6 and 9 under 35 U.S.C. §103(a) as unpatentable over Epley '312 in view of U.S. 5,811,896 to Grad. With all due respect to the office, the Examiner is in error for

the following reasons, and the rejection of Claims 6 and 9, which are dependent on independent Claim 1, must be withdrawn.

Grad discloses and claims a switching device for electrical loads, such as those contemplated for high volume consumer goods as in Christmas tree lights or electrical toys. The present invention is drawn to a personal medical hearing device, and not high volume consumer goods. Moreover, Applicant is unable to find any mention or teaching in Grad that remotely relates to a miniature reed switch assembly let alone a miniature reed switch assembly intended for use with a hearing device adapted to be positioned in the ear canal of a wearer. As discussed above, one of the required elements for a proper §103(a) rejection is that the prior art reference or combination of references must teach or suggest all the limitations of the claims. (*See In re Wilson*).

Furthermore, the teaching or suggestion, as well as the expectation of success, must come from the prior art, not Applicant's disclosure. As pointed out previously (see Applicant's reply to the Office Action dated 23 May 2001, submitted on 24 September 2001) and acknowledged by Grad's disclosure, latchable reed switches were known at least as early as 1987. Applicant's FIG. 1 shows a prior art switch having a biasing magnet (M) positioned on the switch (R) (see page 4, lines 6-14). Applicant is unaware of any teaching or expectation of success in Grad concerning the miniaturization of reed switches or the manufacture of canal hearing devices containing miniature reed switches at the time of the present invention. Indeed, Grad states that his device: "...is *inexpensive*...can be used for *various* electrical loads...comprises only a few *very inexpensive* components and...will be *simple* to produce" (col. 5, lines 19-23). By contrast, in the Examples provided in the specification as filed, Applicant describes the effort required to produce the miniaturized reed switch of the present invention for use in the ear canal of a wearer where the availability of space and power are extremely limited.

For the foregoing reasons, the rejection of Claims 6 and 9, which are dependent on the underlying invention as claimed in independent Claim 1, must fail. The use of Epley '312 in combination with Posey in order to sustain a §103(a) obvious rejection to Claims 6 and 9 in

the instant invention therefore cannot lie and must be withdrawn. Having shown that the rejections of Claims 6 and 9 are in error, these rejections must now be withdrawn. Withdrawal of the §103(a) rejections and further consideration of the claims on the merits is now requested.

THIRD REJECTION UNDER 35 U.S.C. §103(a)

On page 5, in paragraph 7 of the Office Action dated 9 October 2003, the Examiner rejected Claims 11-13, 16, 20, 24 and 25 under 35 U.S.C. §103(a) as being unpatentable over Epley '312. With all due respect to the office, the Examiner is in error and the rejection of these claims based on Epley '312 must be withdrawn.

In the present invention, Claims 11-13 are ultimately dependent upon independent Claim 1; Claims 16 and 20 are ultimately dependent upon independent Claim 15; and Claims 24 and 25 are dependent upon independent Claim 25. Each of independent Claims 1, 15 and 21 have been amended to include the limitation that the reed switch contemplated for use herein comprises part of a miniature reed switch assembly. Thus, the discussions provided above regarding Epley '312 with respect to Claim 1 are also applicable to independent Claims 15 and 21 and, by extension, to dependent Claims 11-13, 16, 20, 24 and 25.

In light of the foregoing and for the reasons already provided above, the rejection of Claims 11-13, 16, 20, 24 and 25 under 35 U.S.C. §103(a) based on Epley '312 are in error and must be withdrawn. The Office is therefore encouraged to withdraw the 35 U.S.C. §103(a) rejections and favorably consider the specification and claims towards allowance.

FOURTH REJECTION UNDER 35 U.S.C. §103(a)

In the Office Action dated 9 October 2003 on page 7, in paragraph 8, the Examiner rejected Claim 14 under 35 U.S.C. §103(a) as unpatentable over Epley '312 in view of U.S. 5,233,322 (Posey '322). With all due respect to the office, the Examiner is in error, and the rejection of Claim 14 must be withdrawn.

Posey '322 discloses and claims a potting compound for a reed switch assembly. Claim 14 is dependent upon Claim 1, which claims a miniaturized reed switch assembly. Neither Posey '322, nor Epley '312, either alone or taken in combination, teach or disclose the miniature reed switch assembly for use in a miniature canal hearing device as described and claimed by Applicant in the present invention, even if the reed switch assembly is potted. Accordingly, the obviousness rejection of Claim 14, which is dependent upon, and necessarily includes the limitations of independent Claims 1, is in error and cannot lie.

Having shown that the 35 U.S.C. §103(a) rejection of Claim 14 based on Epley '312 in view of Posey '322 is in error and must be withdrawn, withdrawal of the rejection of Claim 14 and further consideration of the specification and the claims is now respectfully urged.

FIFTH REJECTION UNDER 35 U.S.C. §103(a)

On page 7, in paragraph 9 of the Office Action dated 9 October 2003, the Examiner rejected Claims 17-19 under 35 U.S.C. §103(a) as being unpatentable over Epley '312 in view of Posey '523. With all due respect to the office, the Examiner is in error and the rejection of Claims 17-19 must be withdrawn.

As discussed above, Posey '523 is directed towards a unidirectional magnetic proximity detector that includes a permeable plate (14) for the absorption of magnetic flux. Epley '312 describes and claims a magnetic attachment device for the insertion and removal of hearing aids. Furthermore, as acknowledged by the Examiner at p.7, paragraph 9, Epley '312 "*does not expressly disclose [that] the latching magnet is directly affixed to said first reed or wedged between ferromagnetic lead wires...*" (emphasis added).

Claims 17-19 are dependent upon, and necessarily include, all the limitations of independent Claim 15, which recites a miniature reed switch assembly. As discussed above, in the specification as originally filed, Applicant describes and includes Examples concerning the effort required to produce the miniaturized reed switch of the present invention for use in the ear canal of the wearer where the availability of space and power are extremely limited. Such

constraints, and the direct attachment of a magnet as part of a miniaturized reed switch assembly, are absent in either of Epley '312, Posey '523, or the combination of the two.

For the foregoing reasons, an obviousness rejection of Claims 17-19 based on Epley '312 and Posey '523, either alone or taken in combination, must fail. Withdrawal of the §103(a) rejection of Claims 17-19 and further consideration of the specification and claims is requested.

SIXTH REJECTION UNDER 35 U.S.C. §103(a)

In the Office Action dated 9 October 2003 on page 8, in paragraph 10, the Examiner rejected Claim 23 under 35 U.S.C. §103(a) as unpatentable over Epley '312 in view of U.S. Pat. No. 5,811,896 (Grad). With all due respect to the office, the Examiner is in error, and the rejection of Claim 23 must be withdrawn.

As indicated above, Grad is directed towards a switching device for electrical loads, such as those contemplated for high volume consumer goods as in Christmas tree lights or electrical toys. As the Examiner has acknowledged, “Epley '312 *does not expressly disclose* the latching magnet is directly affixed to said first reed or wedged between ferromagnetic lead wires...” (emphasis added). Claim 23 is dependent upon independent Claim 21 and must therefore necessarily include all the limitations of independent Claim 21. Claim 21 as amended herein recites a method of remotely activating and deactivating a miniature hearing device that includes a magnetically controlled *miniature* latchable reed switch assembly. There is no mention of the use of a bar magnet to control a miniature latchable reed switch assembly in either Epley '312, Grad, nor the combination of the two.

For the foregoing reasons, the rejection of Claim 23 for obviousness under 35 U.S.C. §103(a) based on Epley '312 in view of Grad must fail. Withdrawal of the §103(a) rejection of Claim 23 and further consideration of the specification and claims towards allowance are now courteously urged.

CONCLUSION

Claims 1-25 are pending in the application; Claims 26-32 having been previously withdrawn from consideration. Claims 1, 15, 17 and 21 are amended herein, as are Figures 4, 5, 6 and 8.

The Examiner's rejections to Claims 1, 7, 8, 10, 15, 21 and 22 under 35 U.S.C. §102(b) have been overcome. Withdrawal of the §102(b) rejections are therefore respectfully urged.

The Examiner's rejections of Claims 2-5, 6, 9, 11-14, 17-19, 20 and 23-25 under 35 U.S.C. §103(a) over Epley '312 either alone or variously in combination with Posey '523, Grad, or Posey '322 have also been overcome. Withdrawal of the §103(a) rejections are therefore respectfully urged.

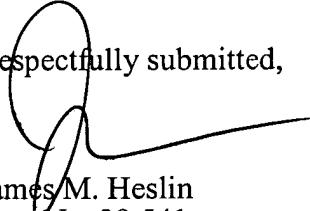
Claims 1-25 define novel and non-obvious subject matter of the present invention. In view of the foregoing Amendments and remarks, it is respectfully submitted that the Claims now presented herein are patentable over the art of record, and that this application is now in condition for allowance. Such favorable action is earnestly solicited. If the next action is other than to allow the claims, the undersigned requests the favor of a short telephonic interview. In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 09/181,533
Amdt. dated April 7, 2004
Reply to Office Action of October 9, 2003

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


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Attachment: *Replacement Sheets*
Annotated Sheet Showing Changes

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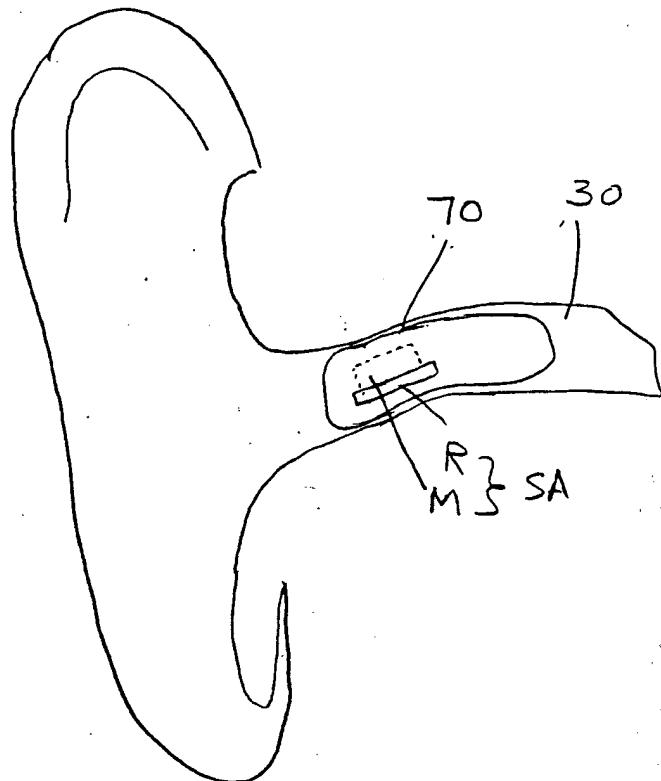
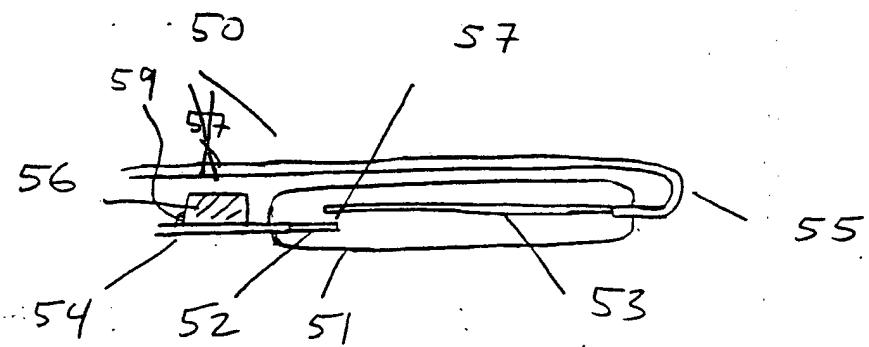
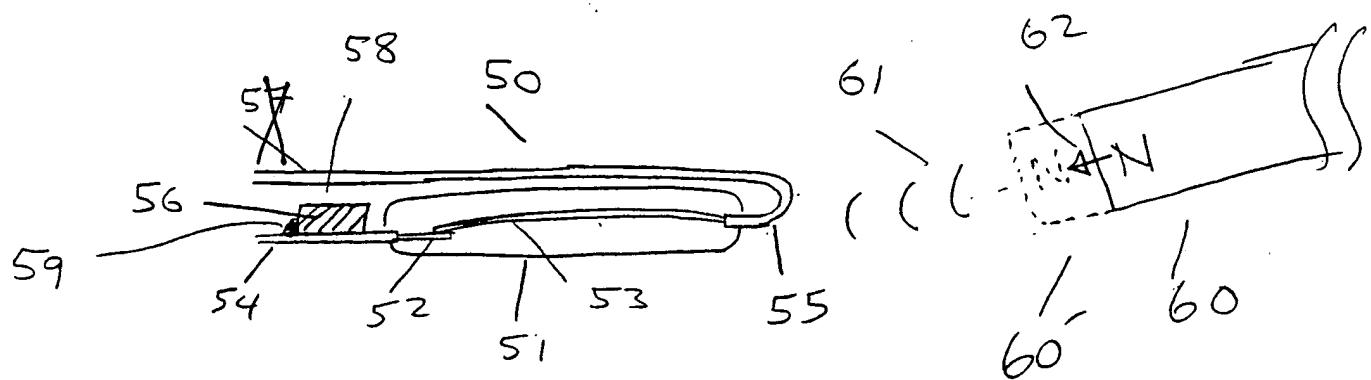


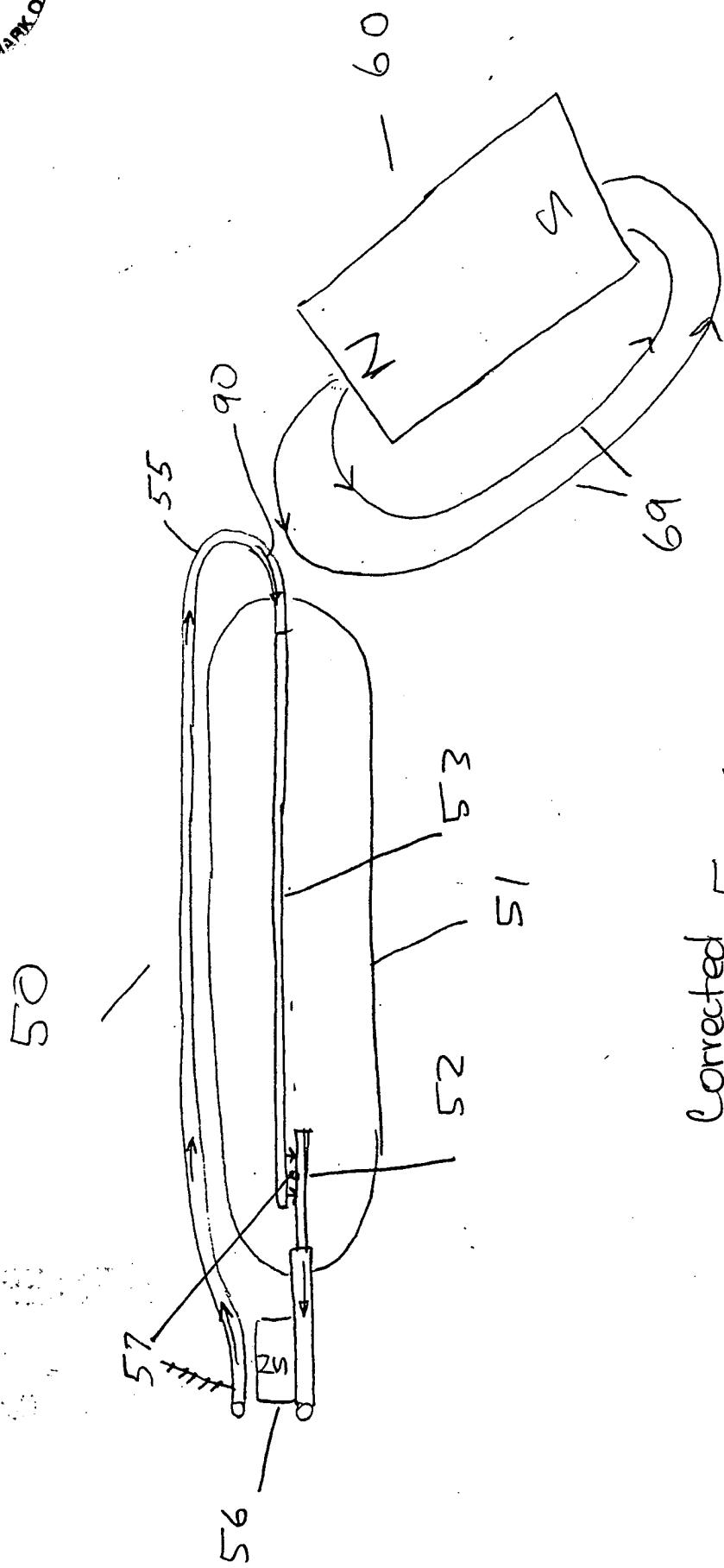
Fig. 3



Corrected Fig. 4



Corrected Fig 5



Corrected Fig 6

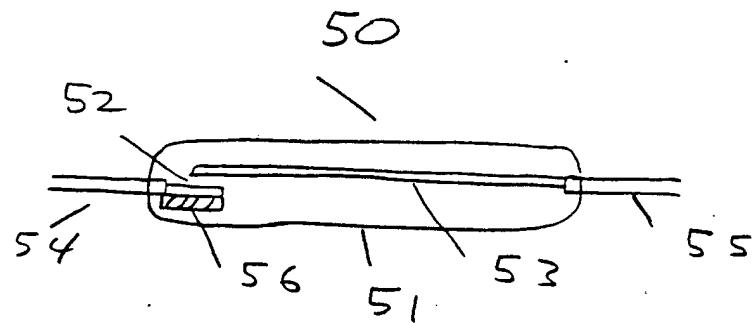
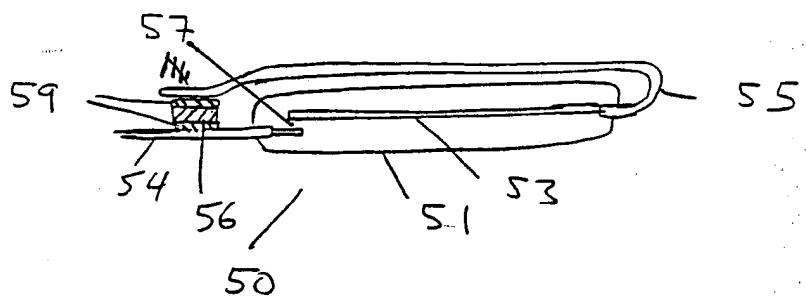


Fig. 7



Corrected Fig. 8